

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Asuka Nishimura *et al.*

Patent No.: 7790957 B2

Confirmation No.: 3574

Granted: September 7, 2010

Art Unit: 1638

For: GENES THAT CONFER REGENERATION
ABILITY TO PLANTS, AND USES THEREOF

Examiner: P. T. Bui

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT UNDER 37 CFR §1.705(b)(2)

Dear Sir:

1. This statement is respectfully submitted in support of the “Application for Patent Term Adjustment Including Request for Reconsideration of Patent Term Adjustment Under 37 CFR §1.705(b)” in the above-referenced patent. In view of the following, it is respectfully requested that Patentees be granted a patent term adjustment of **871 days**.
2. The patent term adjustment per the “Determination of Patent Term Adjustment Under 35 U.S.C. §154(b)” as shown on the face of the issued patent is 751 days. The determination of 751 days is in error for the reasons discussed below.
3. The factual bases for the above adjustment are set forth as follows:

A. Examination Delays Pursuant to 37 CFR §1.702 and §1.703

Pursuant to 37 CFR §1.703(f), the period of adjustment of the term of the patent under §1.702 is the sum of the periods of examination delay calculated under subparagraphs (a)-(e), **to the extent that such periods are not overlapping**, less the sum of the periods calculated under §1.704 (the period of Applicant Delay). In the above-referenced patent, Patentees are entitled to a period of examination delay equal to the sum of the periods of delay under §1.703(a) and (b), for the reasons set forth below.

(i) “14 Month Delay” Pursuant to §1.703(a)(1)

In accordance 37 CFR §1.703(a)(1), Patentees are entitled to a period of patent term adjustment due to the failure by the Office to mail an action under 35 U.S.C. §132 not later than 14 months after the date on which the requirements of 35 U.S.C. § 371 were fulfilled (*i.e.*, by October 17, 2007) (hereinafter “14 Month Delay”). As shown on the Office’s PTA Calculation Sheet (see **Exhibit A**), the Office failed to mail an action under 35 U.S.C. §132 (a Restriction Requirement) until December 31, 2008. Patentees are entitled to a period of patent term adjustment beginning on the day after the date that is 14 months after the date on which the above-referenced patent was filed under 35 U.S.C. §111(a), *i.e.*, October 18, 2007, and ending on the date of mailing of an action under 35 U.S.C. §132, *i.e.*, December 31, 2008. Accordingly, the period of patent term adjustment due to the 14 Month Delay by the Office is **441 days**, which is in agreement with the period calculated by the Office on the PTA Calculation Sheet (**Exhibit A**).

(ii) “Three Years Delay” Pursuant to 37 CFR §1.703(b)

Patentees respectfully submit that the Office did not comply with the requirement of 35 U.S.C. §154(b) and 37 CFR §1.702(b), which requires issuance of a patent within three years after the date on which the national stage commenced under 35 U.S.C. §371, *i.e.*, January 31, 2006. Therefore, in accordance with 37 CFR §1.703, Patentees have calculated a maximum period of Three Years Delay based on the period of time beginning on the day after the date that is three years after the date on which the national stage commenced under 35 U.S.C. §371 (*i.e.*, February 1, 2009), and ending on the date the Patent issued (*i.e.*, September 7, 2010). This period of delay is **584 days**.

(iii) “Four Month Response to Applicant Reply” Pursuant to 37 CFR § 1.702(a)(2)
for delay in responding to Applicants Reply filed on September 21, 2009

In accordance with 37 CFR § 1.720(a)(2), Patentees are entitled to a period of patent term adjustment due to the failure by the Office mail an action under 35 U.S.C. § 132 not later than four months after the date on which the reply was filed (*i.e.*, by January 21, 2010). As shown on the PTA calculation sheet (**Exhibit A**), the Office failed to mail an action under 35 U.S.C. 132 (a Notice of Allowance) until January 27, 2010. As such Patentees are entitled to a period of patent term adjustment of **6 days**. This is consistent with the PTA Sheet (**Exhibit A**) from the USPTO.

(iv) “Four Month PTO Issue of Patent Delay” Pursuant to 37 CFR 1.702(a)(4)

Patentees respectfully submit that the Office did not comply with the requirement of 37 CFR 1.702(a)(4), which requires issuance of a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. §151 and all outstanding requirements were satisfied. As shown on the Office’s PTA calculation sheet (see **Exhibit A**), the Office failed to issue a patent until September 7, 2010. Therefore, Patentees are entitled to a period of patent term adjustment beginning on the day after the date that is four months after the date on which the issue fee was paid, *i.e.*, August 28, 2010, and ending on the date the patent issued, *i.e.*, September 7, 2010. Accordingly, the period of adjustment due to the delay in the issuance of the patent by the Office is **11 days**, which is in agreement with the period calculated by the Office on the PTA calculation sheet (**Exhibit A**).

(v) Total Examination Delay Pursuant to 37 CFR §1.703(f)

As set forth in 37 CFR §1.703(f), the period of examination delay based on the grounds set forth in 37 CFR §1.702 is the sum of the period of 14 Month Delay (441 days), the maximum period of Three Years Delay (584 days), the four month response to Applicant reply delay (6 days) and the four month PTO issue of patent delay (11 days) or 1,042 days, to the extent these periods of delay are not overlapping. As the period of 14 Month Delay ended on December 31, 2008, prior to the first day of the period of Three Years Delay, *i.e.*, February 1, 2009, Patentees submit that these periods are not overlapping. However, the

entire period of the Four Month Response to Applicant Reply Delay (*i.e.*, 6 days) overlaps with a portion of the Three Years Delay. Additionally, the entire period of the Four Month PTO Issue of Patent Delay (*i.e.*, 11 days) overlaps with a portion of the Three Years Delay. Accordingly, the sum of the total examination delays (1,042 days) is reduced by the total periods of overlap (17 days), resulting in a total examination delay of **1,025 days**.

B. “Applicant Delay” Pursuant to 37 CFR §1.704

Pursuant to 37 CFR §1.704 the period of adjustment of the term of the patent due to examination delay is reduced by the period of Applicant Delay. As indicated on the Office’s PTA Calculation Sheet (**Exhibit A**), the Office has calculated a period of Applicant Delay of 151 days minus an additional 123 days (= 274 days). Patentees respectfully submit that the correct period of Applicant Delay is **154 days** and seek correction based on the following remarks.

(i) Applicant Delay for Responding to Non-Final Action Dated May 21, 2009

Patentees respectfully submit that a period of Applicant Delay of **31 days** accrued for the delayed submission of an Amendment and Response on September 21, 2009. This is consistent with the PTA Sheet (**Exhibit A**) from the USPTO. Accordingly, pursuant to 37 CFR § 1.704(b), this 31 day period should be considered an Applicant Delay.

(ii) Applicant Delay for Filing a Supplemental Information Disclosure Statement on January 21, 2010

Patentees respectfully submit that an additional period of Applicant Delay of **123 days** accrued for the submission of a Supplemental Information Disclosure Statement on January 21, 2010. This Supplemental Information Disclosure Statement was filed 123 days after the filing of a Response to Non-Final Action by Applicants on September 21, 2009. This is consistent with the PTA Sheet (**Exhibit A**) from the USPTO. Accordingly, pursuant to 37 CFR § 1.704(c)(8), this 123 day period should be considered an Applicant Delay.

(iii) Amendment or Paper after Notice of Allowance

Patentees respectfully submit that a Request for Corrected Filing Receipt was filed on March 25, 2010, after the mailing of the Notice of Allowance. However, for the following

reasons, Patentees respectfully submit that the Office incorrectly added a 120 day period to the Applicant Delay period.

a) The Office did not correct the error on the Filing Receipt upon receipt of Applicants' request of November 25, 2009

On November 25, 2009, Applicants requested that the Filing Receipt be corrected to list the correct spelling of the Assignee's name (*i.e.*, from Honda Motors Co., LTD, Tokyo, Japan to Honda Motor Co. , LTD, Tokyo, Japan). As this correction was not fixed on the filing receipt mailed on November 27, 2009, it was necessary for Applicants to submit an additional Request for Corrected Filing Receipt. Accordingly, Patentees submit that they did not fail to engage in reasonable efforts to conclude prosecution, and that this period of delay should not be counted against Patentees.

b) A Request for Corrected Filing Receipt, should not be counted as a paper that causes substantial interference and delay in the patent issue process

Even if the Office determines that Applicants Request for Corrected Filing Receipt of March 25, 2010 was not necessary in view of the Office's failure to correct the Filing Receipt after Applicants request of November 25, 2009, Patentees submit that the Request for Corrected Filing Receipt should not be counted as the submission of a paper after a Notice of Allowance that causes substantial interference and delay in the patent issue process because it is not cited as such in the OG notice of May 29, 2001 (see **Exhibit B**).

c) If the Office determines that a Request for Corrected Filing Receipt counts towards Applicants delay, Patentees should only be debited 5 days, not 120 days

Alternatively, even if the Office determines that a Request for Corrected Filing Receipt is a paper that causes substantial interference and delay in the patent issue process, Patentees respectfully submit that pursuant to 37 CFR §1.312, they should only be debited the time period beginning on the date the Request was filed (*i.e.*, March 25, 2010) and ending on the mailing date of the Response (the corrected Filing Receipt) from the Office (*i.e.*,

March 29, 2010). Accordingly, if the Office determines that the Request for Corrected Filing Receipt is a paper that causes substantial interference and delay in the patent issue process, Patentees respectfully submit that the correct period of Applicant delay is **5 days, not 120** days, and request appropriate correction by the Office.

(iv) **Calculation of the Total Period of Applicant Delay**

In view of the above, Patentees have calculated a total period of Applicant Delay of **154 days**, which is the sum of the following Applicant Delays: (i) the 31 day period; and (ii) the 123 day period.

Alternatively, if the Office determines that the Request for Corrected Filing Receipt is a paper that causes substantial interference and delay in the patent issue process, Patentees have calculated a total period of Applicant Delay of **159 days**, which is the sum of the following Applicants Delays: (i) the 31 day period, (ii) the 123 day period, and (iii) the 5 day period.

Patentees note that this calculation differs from the USPTO's determination of 274 days (151 days + 123 days) of Applicant Delay, as shown on the PTA Sheet (**Exhibit A**). Patentees respectfully submit that the correct period of Applicant Delay is **154 days, not 274 days**, and request appropriate correction by the Office.

C. Calculation of Correct Patent Term Adjustment Pursuant to 37 CFR §1.702(f)

As set forth in 37 CFR §1.703(f), Patentees are entitled to a period of patent term adjustment equal to the period of examination delays reduced by the period of Applicant Delay. Therefore, Patentees submit that the correct patent term adjustment for the above-referenced patent is **871 days**, or alternatively **866 days**, which is the difference between the total period of examination delay (1025 days) and the Applicant Delay (154 days, or alternatively 159 days).

4. In accordance with 37 CFR§1.705(b)(2)(iii), Patentees submit that this patent is not subject to a terminal disclaimer.

In view of the foregoing, it is respectfully requested that this Request for Reconsideration of Patent Term Adjustment be favorably considered and that a corrected Determination of Patent Term Adjustment be issued to reflect a patent term adjustment of **871 days**.

Dated: October 27, 2010

Respectfully submitted,

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